

REMARKS

Claims 148-203 have been canceled without prejudice or disclaimer. Claims 204-206 have been added and therefore are pending in the present application. Claims 204-206 are supported by claims 148-203.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I. The Rejection of Claims 148, 183, 197, 200 and 202 under 35 U.S.C. 112

Claims 148, 183, 197, 200 and 202 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

It is well settled that "[t]he test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter...." *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

As set forth in Federal Circuit decisions, a specification complies with the written description requirement if it provides "a precise definition, such as by structure, formula, chemical name, or physical properties of the claimed subject matter sufficient to distinguish it from other materials." See, e.g., *University of California v. Eli Lilly and Co.*, 43 U.S.P.Q.2d 1398, 1404 (Fed. Cir. 1997); *Enzo Biochem v. Gen-Probe Inc.*, 63 U.S.P.Q.2d 1609, 1613 (Fed. Cir. 2002).

The test is not whether one of ordinary skill in the art envisions all of the claimed subject matter. Indeed, the Federal Circuit held that, "It is not correct ... that all functional descriptions of genetic material fail to meet the written description requirement." *Enzo Biochem v. Gen-Probe Inc.*, 63 U.S.P.Q.2d at 1613.

The claimed invention is drawn to variants of a cellulase of SEQ ID NO: 5, comprising a substitution at position 119 with H. The specification describes a number of other positions, including specific mutations, which can be combined with the claimed substitution. Moreover, other positions for mutation have been described in the art. Thus, the specification fully describes the cellulase variants of the present invention.

Moreover, the Office is incorrect that the claimed variants are not defined by structure. The claims specify that the parent cellulase is the cellulase of SEQ ID NO: 5 and that the variant has endoglucanase activity. Thus, the structure of the claimed variants is inherent.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

II. The Rejection of Claims 148, 183, 197, 200 and 202 under 35 U.S.C. 112

Claims 148, 183, 197, 200 and 202 are rejected under 35 U.S.C. 112, first paragraph, while being enabling for a modified endoglucanase having the structure of SEQ ID NO: 5 mutated at a single position corresponding to residue 119 in SEQ ID NO: 1, does not reasonably provide enablement for a modified endoglucanase of SEQ ID NO: 5 comprising said specific mutation. This rejection is respectfully traversed.

It is well settled that "a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." *In re Marzocchi*, 169 U.S.P.Q. 367, 369 (C.C.P.A. 1971).

Moreover, "[a]ny assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubts so expressed." *In re Dinh-Nguyen*, 181 U.S.P.Q. 46, 47 (C.C.P.A. 1974). Thus, the burden is upon the Patent Office to set forth reasonable grounds in support of its contention that a claim reads on inoperable subject matter). See *In re Stark*, 172 U.S.P.Q. 402, 406 n. 4 (C.C.P.A. 1972).

The claimed invention is drawn to variants of a cellulase of SEQ ID NO: 5, comprising a substitution at position 119 with H. The specification describes a number of other positions, including specific mutations, which can be combined with the claimed substitution. Moreover, other positions for mutation have been described in the art. Thus, the specification fully enables the cellulase variants of the present invention.

Moreover, the Office is incorrect that the claimed variants are not defined by structure. The claims specify that the parent cellulase is the cellulase of SEQ ID NO: 5 and that the variant has endoglucanase activity. Thus, the structure of the claimed variants is inherent.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

III. The Rejection of Claims 148, 183 and 200 under 35 U.S.C. 103

Claims 148, 183 and 200 are rejected under 35 U.S.C. 103 as being unpatentable over Schulein et al. (A) (U.S. Patent No. 6,001,639) in view of Schulein et al. (B) (WO 94/07998). This rejection is respectfully traversed.

Schulein et al. (A) and Schulein et al. (B) disclose various cellulases and variants thereof. However, neither Schulein et al. reference teaches or suggests the cellulase variants of the present invention.

In order to advance prosecution, the new claims are drawn to variants of a cellulase of SEQ ID NO: 5, comprising a substitution at position 119 with H. The Office indicated that the substitution Q119H is patentable. Applicants reserve the right to file a continuation on the cancelled subject matter.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. The Rejection of Claim 198 under 35 U.S.C. 112

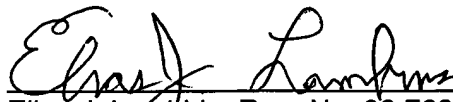
Claim 198 is rejected under 35 U.S.C. 112 as being indefinite. Specifically, the Office objected to the phrase "the modified cellulase of claim 148, consisting of Q119H."

Applicants submit that this phrase is clear and definite. However, in order to advance prosecution, claim 198 has been rewritten as claim 205, as suggested by the Examiner. Therefore, this rejection has been overcome.

V. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Elias J. Lambiris", is written over a horizontal line.

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